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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,137	11/04/2005	Sergei Levchik	1321-18 PCT US	8471
28249 7590 11/29/2007 DILWORTH & BARRESE, LLP 333 EARLE OVINGTON BLVD. SUITE 702 UNIONDALE, NY 11553			EXAMINER SELLERS, ROBERT E	
			ART UNIT	PAPER NUMBER
			1796	
			MAIL DATE	DELIVERY MODE
			11/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/534,137

Applicant(s)

LEVCHIK ET AL.

Examiner

Robert Sellers

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The 35 U.S.C. 103(a) rejections involving Japanese Patent No. 2002-88138 are withdrawn. The Japanese patent on page 4 in paragraph 19 shows an aromatic phosphonic acid ester of Formula II wherein X_2 can be a direct bond and R_2 includes an alkyl group. However, none of the depicted and exemplified species set forth on pages 4-7 in Formulae 7-23 shows the claimed lower alkyl group R in the claimed phosphonate repeating structure.

2. According to MPEP § 2144.08 II. Determine Whether the Claimed Species or Subgenus Would Have Been Obvious to One of Ordinary Skill in the Pertinent Art at the Time the Invention Was Made, 4. Determine Whether One of Ordinary Skill in the Art Would Have Been Motivated to Select the Claimed Species or Subgenus:

"Office personnel should determine whether one of ordinary skill in the relevant art would have been motivated to make the claimed invention as a whole, i.e., to select the claimed species or subgenus from the disclosed prior art genus

(*In re Ochiai*, 37 USPQ2d at 1127, 1131, Federal Circuit 1995; *In re Deuel*, 34 USPQ 2d, 1210, 1215, Federal Circuit 1995; *In re Jones*, 21 USPQ 2d 1941, 1943, Federal Circuit 1992; *In re Dillon*, 16 USPQ 2d 1897, 1901, Federal Circuit 1990 and *In re Lulu*, 223 USPQ 1257, 1258, Federal Circuit 1984)."

3. There is no motivation in the reference or by any other reasoning to selected a particular oligomer among the myriad types encompassed by Formula 5 of the Japanese patent wherein X_2 is a direct bond and R_2 is alkyl, especially considering the lack of such a substituent in any of the exhibited and exemplified species.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of copending application no. 10/491,690 in view of Japanese Patent No. 2001-302879 (Japanese '879).

4. Although the conflicting claims are not identical, they are not patentably distinct from each other. The claims of the copending application define an thermoset resin composition comprising the an epoxy resin (claim 9) and the claimed hydroxy-terminated phosphonate oligomer with the repeating structure $-O-P(=O)(R)O-Arylene$ wherein R is alkyl.

5. The claimed inorganic filler and polybenzoxazine of new claim 18 are not recited. Japanese '879 (CAPLUS abstract, mentioned in the instant specification on page 3, lines 5-10 as describing the claimed inorganic filler, co-curing agent and polybenzoxazine) exemplifies a composition comprising an epoxy resin, 21.2% by weight of a phosphorus-containing phenol novolak resin 21.2% by weight of an aluminum hydroxide filler (alumina is disclosed on page 3, paragraph 11), and 25.5% by weight of a polybenzoxazine and 10.6% by weight of a phosphorus compound. It would have been obvious to incorporate the filler and polybenzoxazine of Japanese '879 into the composition of the copending application in order to improve the fire retardancy (Japanese '879, page 3, paragraph 11).

6. The copending application has an effective filing date of October 4, 2002 which is before the effective filing date for the instant application of November 8, 2002.

MPEP § 804, I. Instances Where Double Patenting Issue Can Be Raised,

B. Between Copending Applications—Provisional Double Patenting,

1. Nonstatutory Double Patenting Rejection: "If the ODP rejection is the only rejection remaining in the later-filed application, while the earlier-filed application is rejectable on other grounds, a terminal disclaimer must be required in the later-filed application before the rejection can be withdrawn." Since the instant application is later-filed, a terminal disclaimer is required.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending application no. 10/557,812 in view of Japanese '879.

7. Although the conflicting claims are not identical, they are not patentably distinct from each other. The claims of the copending application denotes a composition containing an epoxy resin and an epoxy-reactive polyphosphonate such as the species of claims 6-10 which are hydroxy-terminated and contain arylene groups as the Y substituent and the R group bonded to the phosphonate moiety is a lower alkyl according to page 3, lines 24-25 of the specification.


8. The claimed inorganic filler and polybenzoxazine of new claim 18 are not recited. It would have been obvious to incorporate the filler and polybenzoxazine of Japanese '879 into the composition of the copending application in order to improve the fire retardancy (Japanese '879, page 3, paragraph 11).

9. Although the effective filing date for the copending application of May 19, 2004 is after the effective filing date of November 8, 2002, the rejection is applied since the copending application has yet to be examined and this double patenting rejection is not the only remaining rejection in the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Provisional application nos. 60/327,018 and 60/406,011 contains claims relevant to the instant claims but they have expired and no applications have been filed.

(571) 272-1093 (Fax No. (571) 273-8300) Monday to Friday, 9:30 to 6:00


ROBERT E.L. SELLERS
PRIMARY EXAMINER